

REMARKS

This is a full and timely response to the final Official Action mailed **February 12, 2008** (the "Action") and the Advisory Action mailed April 21, 2008. Reconsideration of the application in light of the following remarks is respectfully requested.

Claim Status:

Claims 16-27 were withdrawn under a previous restriction requirement and cancelled without prejudice or disclaimer.

No amendments to the application are made by the present paper. Thus, claims 1-15, 28, and 30-33 are currently pending for further action.

35 U.S.C. § 112:

Claims 1-15, 28 and 30-33 were rejected as being unpatentable under 35 U.S.C. § 112, first paragraph, on grounds that the application as filed did not comply with the written description requirement. Specifically, the Action charges that the original specification did not provide a written description that "the furniture is manufactured and then purchased." (Action, p. 2). Presumably, by this the Examiner means to say that there is no written description for the recitations in claim 1 of

manufacturing said piece of furniture to be sold to a purchaser for whom said piece of furniture will become said heirloom;

after sale of said piece of furniture to said purchaser, preparing one or more handwritten writings by hand directly on the wood of which said piece of furniture is made, wherein said handwritten writings enhance said value of said piece of furniture as an heirloom as compared to said piece of furniture as purchased from a manufacturer absent said handwritten writings.

Applicant respectfully disagrees.

Applicant's originally-filed specification states the following.

The piece of furniture (101) may also be associated with a set of instructions (130) that explain the intended use of the plank, tablet or drawer as a surface to receive writings or other markings that record history, e.g., the history of the furniture owner or owners. The furniture (101) may be offered for sale with the instructions (130) associated with the furniture, e.g., tied, taped or secured to the furniture or displayed with the furniture. (Applicant's specification, paragraph [0023])

This paragraph clearly provides a written description for the aspects in question of the claimed method of enhancing the value of a piece of furniture as an heirloom. As stated in the quoted paragraph 0023, a piece of furniture (which has already been manufactured) is "offered for sale" and sold with instructions that suggest preparing handwritten writing on the otherwise blank "plank, tablet or drawer as a surface to receive writings or other markings that record history," i.e., that enhance the value of the furniture as an heirloom. Additionally, a blank, unwritten plank, existing after manufacture and before being sold and written on, is shown in Fig. 8.

Consequently, the charge in the Office Action that claims 1-15, 28 and 30-33 lack a sufficient written description in the originally-filed specification as required by 35 U.S.C. § 112, first paragraph, is entirely without merit. Therefore, the Examiner is respectfully requested to reconsider and withdrawn the rejection under 35 U.S.C. § 112, first paragraph.

Applicant notes that there is no response to this argument in the Advisory Action of April 21, 2008. The Examiner has maintained the § 112 rejection with no explanation as to why the cited paragraph above does not adequate support the claimed subject matter.

Prior Art:

With regard to the prior art, claims 1 and 12 were rejected under 35 U.S.C. § 102 by an affidavit (Exhibit A) provided by the Examiner. For at least the following reasons, this rejection should be reconsidered and withdrawn.

First, the Exhibit does not describe prior art. Exhibit A is described in the Office Action as documenting an instance in which “after constructing [a] wooden nightstand, the artisan, Donald Wiehe wrote his name in the side/plank of the extendable drawer.” (Action, p. 3). Consequently, the Exhibit describes the acts of one private individual and includes absolutely no evidence or statement that such acts were performed publicly or were previously public knowledge. Consequently, the Exhibit cannot be said to provide any evidence on the state the prior art, which must be publicly available information. Thus, the Exhibit is irrelevant to any question of patentability regarding Applicant’s claims.

In response, the Advisory Action states that “Ms. Wiehe-Kaylor bought the nightstand in the affidavit at the auction of her uncle. An affidavit stating such will be requested from Mr. Wiehe-Kaylor.” (Advisory Action of 4/21/08, p. 2).

However, even if such an affidavit were obtained, it would be irrelevant to the method recited in claim 1. Claim 1 does not describe a piece of furniture sold by a manufacturer who signed the furniture before selling it. Whether the sale was a public auction is irrelevant.

Additionally, claim 1, now recites:

A method for enhancing a value of a piece of furniture as an heirloom by storing handwritten writings on said piece of furniture, wherein said piece of furniture is made of wood, said method comprising:

manufacturing said piece of furniture to be sold to a purchaser for whom said piece of furniture will become said heirloom;

after sale of said piece of furniture to said purchaser, preparing one or more handwritten writings by hand directly on the wood of which said piece of furniture is made, wherein said handwritten writings enhance said value of said piece of furniture as an heirloom as compared to said piece of furniture as purchased from a manufacturer absent said handwritten writings; and
storing said handwritten writings on said piece of furniture,
wherein said furniture comprises a member comprising a surface of said wood that is specifically configured to permanently receive said handwritten writings.
(Emphasis added).

In contrast to claim 1, as noted above Exhibit A documents an instance in which “after constructing [a] wooden nightstand, the artisan, Donald Wiehe wrote his name in the side/plank of the extendable drawer.” (Action, p. 3). Applicant’s claim 1, however, does not address or encompass such an instance where an artisan or manufacturer signs a piece of furniture as a craftsman.

Moreover, the statements of the Advisory Action indicate that the furniture in question in the affidavit of record was signed by the manufacturer and then sold at auction. This is expressly contrary to the method claimed and further demonstrates that no valid prior art rejection can be made of claim 1 based on the present record, including the affidavit of Ms. Wiehe-Kaylor.

Claim 1 recites a method that is conducted primarily after a piece of furniture is manufactured and “sold to a purchaser for whom said piece of furniture will become [an] heirloom.” When sold, the furniture is “absent said handwritten writings” that will subsequently enhance the value of the furniture as an heirloom. Specifically, claim 1 recites “*after sale of said piece of furniture to said purchaser, preparing one or more handwritten writings by hand directly on the wood of which said piece of furniture is made, wherein said handwritten writings enhance*

said value of said piece of furniture as an heirloom as compared to said piece of furniture as purchased from a manufacturer absent said handwritten writings.” (Emphasis added).

In contrast, the situation documented by Exhibit A as further described in the Advisory Action of April 21st, does not teach, suggest or anticipate the method as now recited in claim 1. Exhibit A does not describe, teach or suggest a method in which “after sale of said piece of furniture to said purchaser, preparing one or more handwritten writings by hand directly on the wood of which said piece of furniture is made, wherein said handwritten writings enhance said value of said piece of furniture as an heirloom as compared to said piece of furniture as purchased from a manufacturer absent said handwritten writings.”

“A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. For at least these reasons, the rejection based on Exhibit A of claim 1 and its dependent claims should be reconsidered and withdrawn.

Next, claims 1-15, 28 and 30-32 were rejected under 35 U.S.C. § 103(a) over the combined teachings of U.S. Patent No. 788,946 to Robie (“Robie”) and U.S. Patent No. 977,349 to Wagner (“Wagner”) and Exhibit A. As noted above, Exhibit A is not prior art and irrelevant to this discussion. With that understanding, for at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 28 now recites:

A method for enhancing a value of a piece of furniture as an heirloom by storing handwritten writings on said piece of furniture, wherein said furniture comprises a member that is specifically configured to permanently receive said handwritten writings, said method comprising:

manufacturing said piece of furniture to be sold to a purchaser for whom said piece of furniture will become said heirloom; and

specifically designating said member as being intended to receive said handwritten writings in materials presented with said furniture when said furniture is offered for sale and has not yet received said handwritten writings.

(Emphasis added).

The recent Office Action does not appear to address claim 28 or to explain how or where the cited prior art is thought to teach or suggest the subject matter of claim 28. Specifically, the cited prior art does not anywhere teach or suggest the claimed method including “specifically designating said member as being intended to receive said handwritten writings in materials presented with said furniture when said furniture is offered for sale and has not yet received said handwritten writings.” This subject matter appears to be entirely outside the scope and content of the cited prior art. For at least these reasons, no *prima facie* case of unpatentability has been made as to claim 28.

Additionally, as noted above, Claim 1 now recites:

A method for enhancing a value of a piece of furniture as an heirloom by storing handwritten writings on said piece of furniture, wherein said piece of furniture is made of wood, said method comprising:

manufacturing said piece of furniture to be sold to a purchaser for whom said piece of furniture will become said heirloom;

after sale of said piece of furniture to said purchaser, preparing one or more handwritten writings by hand directly on the wood of which said piece of furniture is made, wherein said handwritten writings enhance said value of said piece of furniture as an heirloom as compared to said piece of furniture as purchased from a manufacturer absent said handwritten writings; and

storing said handwritten writings on said piece of furniture,
wherein said furniture comprises a member comprising a surface of said wood
that is specifically configured to permanently receive said handwritten writings.

In contrast, the combination of Robie and Wagner fails to teach or suggest this claimed method.

Robie teaches an “Index for Supply-Cabinets.” (Robie, title). According to Robie, “drawer[s are] arranged with a series of general compartments 12, covered by a hinged cover 13, said compartments being subdivided into smaller compartments 14, as shown. On the top face of each cover is printed an index 15, indicating the general nature of the goods to be found beneath said cover.” (Robie, col. 1, lines 44-50).

Consequently, Robie is merely teaching a method of organizing a supply cabinet. Robie’s teachings are completely irrelevant to the claimed method “for enhancing a value of a piece of furniture as an heirloom by storing handwritten writings on said piece of furniture.” Robie teaches nothing about enhancing the value of an heirloom.

Robie further does not teach or suggest “manufacturing said piece of furniture to be sold to a purchaser for whom said piece of furniture will become said heirloom.”

Robie does not teach or suggest “after sale of said piece of furniture to said purchaser, preparing one or more handwritten writings by hand directly on the wood of which said piece of furniture is made.” Robie does not even indicate whether the “printed” labels for the storage compartments are handwritten. (Robie, col. 1, lines 48-50).

Robie does not teach or suggest “wherein said handwritten writings enhance said value of said piece of furniture as an heirloom as compared to said piece of furniture as purchased from a manufacturer absent said handwritten writings.” Robie has nothing to do with this subject mater.

Robie is also silent as to whether the described storage-cabinet is even made of wood. Consequently, the Office Action cites to Wagner for the sole purpose of showing that “wooden furniture with a drawer (5) having a cover/plank (7) is well known in the art.” (Action, p. 3). Consequently, as will be readily understood, Wagner does not remedy any of the failings of Robie outlined above.

Therefore, the combined teachings of Robie and Wagner fail to teach or suggest much of the subject matter of amended claim 1.

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Robie and Wagner, failed to include the method claimed by Applicant. Specifically, the cited prior art does not provide a method for enhancing the value of a piece of furniture as an heirloom by, after sale of said piece of furniture to a purchaser, preparing one or more handwritten writings by hand directly on the wood of which said piece of furniture is made, wherein said handwritten writings enhance said value of said piece of furniture as an heirloom as compared to said piece of furniture as purchased from a manufacturer absent said handwritten writings. This method appears to be entirely outside the scope and content of the cited prior art. This substantial difference between the cited prior art and the claimed method is significant because the claimed method provides functionality and advantages that were unrecognized and, therefore, unavailable, in the cited prior art.

For at least these reasons, Robie and Wagner will not support a rejection of claim 1 under 35 U.S.C. § 103(a) and *Graham*. Therefore, the rejection of claim 1 should be reconsidered and withdrawn.

Claim 2 recites “preparing said member with markings to facilitate placement of said writings on said member.” In this regard, the Office Action argues that “the use of lines on members to aid in adding written material thereon (so that the words/letters are written in a straight line) is well known. Therefore, to etch such grooves in the planks of Robie in view of Wagner, would have been an obvious design consideration.” (Action, p. 3). Applicant respectfully disagrees.

This argument from the Office Action is circular. The argument presumes, incorrectly, that Robie and Wagner already teach placing handwriting on a piece of furniture. This, however, has not been shown. As demonstrated above, Robie merely teaches labeling on storage compartments without ever teachings that the labeling is handwritten. If one is not writing on the furniture by hand, there is no reason to add lines “to aid in adding written material.” (*Id.*).

Consequently, the reasoning of the Office Action in rejecting claim 2 is circular and fallacious and should be reconsidered and withdrawn. The cited prior art has *not* been shown to teach or suggest “further comprising preparing said member with markings to facilitate placement of said writings on said member.” For at least this reason, claim 2 should be considered patentable over the cited prior art.

Claim 3 recites “moving said member from a retracted position to an exposed position prior to storing said writings.” The recent Office Action does not appear to specifically address claim 3. The combination of Robie and Wagner does not appear to specifically teach that, after purchase of a piece of furniture, the purchaser moves a member specifically configured to permanently receive handwritten writings to an expose position from a retracted position “prior to storing said writings.” For at least this additional reason, the rejection of claim 3 should be reconsidered and withdrawn.

With regard to claims 9-11, Applicant notes that claim 1 now specifically recites a method of “enhancing a value of a piece of furniture as an heirloom.” This method is performed, and the desired function is achieved, by “storing handwritten writings on said piece of furniture.” Consequently, the existence and the nature of the writings bear directly on the method and its function.

Accordingly, claim 9 recites “wherein said writings commemorate a specific time in history, person, or historical event.” Such writings, commemorating “a specific time in history, person, or historical event,” clearly have functionality in the objective of the claimed method: “enhancing a value of a piece of furniture as an heirloom.”

In contrast, the combination of Robie and Wagner utterly fails to teach or suggest the claimed method for “enhancing a value of a piece of furniture as an heirloom.” Accordingly, Robie and Wagner also utterly fail to teach or suggest writings prepared according to the claimed method where those writings “commemorate a specific time in history, person, or historical

event.” For at least this additional reason, the rejection of claim 9 should be reconsidered and withdrawn.

Claim 10 recites “wherein said writings comprise a signature.” The signature of an owner, i.e., “purchaser,” clearly has functionality in the objective of the claimed method: “enhancing a value of a piece of furniture as an heirloom.”

In contrast, the combination of Robie and Wagner utterly fails to teach or suggest this subject matter. For at least this additional reason, the rejection of claim 10 should be reconsidered and withdrawn.

Claim 11 recites “wherein said writings comprise a date.” Having an owner, i.e., “purchaser,” date a piece of furniture in his or her own handwriting clearly has functionality in the objective of the claimed method: “enhancing a value of a piece of furniture as an heirloom.”

In contrast, the combination of Robie and Wagner utterly fails to teach or suggest this subject matter. For at least this additional reason, the rejection of claim 11 should be reconsidered and withdrawn.

Claim 13 recite “further comprising storing memorabilia associated with said writings in a storage compartment in said piece of furniture.” The recent Office Action does not appear to address claim 13 or to explain how or where the cited prior art is thought to teach or suggest the subject matter of claim 13. For at least these reasons, no *prima facie* case of unpatentability has been made as to claim 13.

Claims 30-32 depend from claim 23 and recite “wherein said markings comprise a genealogical form;” “wherein said genealogical form comprises a family tree;” “wherein said genealogical form comprises a pedigree chart.” Clearly, these specific recited and claimed markings have functionality in the objective of the claimed method: “enhancing a value of a piece of furniture as an heirloom.”

In contrast, the combination of Robie and Wagner utterly fails to teach or suggest this subject matter. For at least this additional reason, the rejection of claims 30-32 should be reconsidered and withdrawn.

Conclusion:

In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

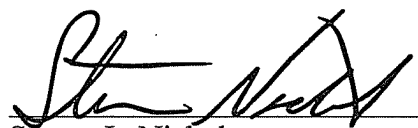
The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily

signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

If any fees are owed in connection with this paper that have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC.

Respectfully submitted,



Steven L. Nichols
Registration No. 40,326

DATE: May 2, 2008

Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095
(801) 572-8066
(801) 572-7666 (fax)